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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,322	11/26/2003	Douglas P. Seams	067083.0229	9469
26231	7590	02/23/2005	EXAMINER	
FISH & RICHARDSON P.C. 5000 BANK ONE CENTER 1717 MAIN STREET DALLAS, TX 75201			NEUDER, WILLIAM P	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/723,322

**Applicant(s)**

SEAMS, DOUGLAS P.

**Examiner**

William P Neuder

**Art Unit**

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 35-80 is/are allowed.
- 6) ☒ Claim(s) 10-14, 19-25 and 28-34 is/are rejected.
- 7) ☒ Claim(s) 15-18, 26 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/16/04, 3/8/04</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-14, 19-25 and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews.

Matthews discloses a method of producing resources found in a formation 26. Looking at figure 5, the horizontal portion of the well is a drainage portion. The first end of the well is coupled to the surface and the second end is in the formation. Injection tube 80 is placed within the well. Fluid flow is generated in the tube from the first end near the surface to the second end in the formation. The produced mixture is collected and includes fines and resources from the formation mixed with the liquid and fines. Matthews is considered to disclose all of the claimed features of claim 10 except for the formation being a coal seam. The method and device of Matthews can be used in any

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type of formation and it would have been considered obvious to use the device and method of Matthews in a coal seam since a coal seam is a known formation. As to claim 11, liner 82 is placed in the well without providing any support for collapse of the wellbore. A plurality of apertures 145, 144 are provided in the liner wall. As to claim 13, the liner diameter is at least ten per cent smaller than the well diameter. As to claims 12 and 24, while Matthews is silent as to the size of his openings, the size of the openings would have been considered an obvious design choice depending upon the size of particulate one would want to exclude from entering the production string. As to claims 14, 19, 20, 25, 30 and 31, the exact diameters of the well and liner would have been considered an obvious design choice dependent upon formation characteristics. As to claims 21 and 32, the second end of the wellbore is further from the surface than the first end. As to claim 22, the drainage portion is substantially horizontal. As to claim 23, liner 82 is at least ten per cent smaller than the wellbore diameter. Apertures 144, 145 are provided in the liner wall. As to claim 28, fluid flow is generated from the second end to the first through tube 80 that is positioned within the liner. In other words, claim 28 does not preclude a reading of the tube 80 being within the liner to generate the flow. As to claim 29, one of the injected fluids can be water. As to claim 33, the angle is approximately 0 degrees. As to claim 34, liner 82 is positioned without support for preventing collapse of the formation.

***Claim Objections***

Claim 77 is objected to because of the following informalities: In line 6, "a drainage well bore" should be --the drainage well bore--. Appropriate correction is required.

***Allowable Subject Matter***

Claims 15-18,26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

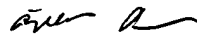
Claims 1-9 and 35-80 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P Neuder whose telephone number is 703-308-2150. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William P Neuder  
Primary Examiner  
Art Unit 3672

W.P.N.